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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,927	04/09/2001	Takeo Hara	205746US0	8486

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EXAMINER

TRINH, MICHAEL MANH

ART UNIT PAPER NUMBER

2822

DATE MAILED: 07/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/827,927

Applicant(s)

HARA ET AL.

Examiner

Michael Trinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 4/24/03 & 12/31/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 and 13-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

\*\*\* This office action is in response to Applicant's amendment December 31, 2002 and Election filed on April 04, 2003. Claims 1-57 are currently pending, in which claims 1-11 and 13-57 are non-elected.

***Election/Restrictions***

1. Applicant's election filed 4/4/03 with traverse of claim 12 in Paper No. 13 is acknowledged. The traversal is on the ground(s) that "...the search and examination of an entire application can be made without serious burden..., since the previous Examiner already examined all of the claims of Groups I-VI on the merits...". This is not found persuasive because these multiple inventions are distinct for reasons and given example(s) as of record and have acquired a separate status, in which the fields of search are not co-extensive and separate examination would be required for these distinct inventions, and because Applicant did not even contravene the supposed errors of the given examples, and/or did not distinctly and specifically point out the supposed errors of the examples in the restriction requirement. Searching, considering and examining these multiple distinct inventions imposed serious burden on the previous examiner. In view of applicant's separately remarks for the distinction of each group of inventions, examining, considering and searching all of these multiple distinct inventions would further impose more serious burden on the examiner and to the Office. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. However, in this instant case, no evidence and/or admission have been submitted by Applicant. Accordingly, examination, searching, and considering patentability of all of these multiple distinct species invention would be a very serious burden to the examiner. Because these species inventions are distinct for the reasons given above, the field of search are not co-extensive and separate examination would be required, restriction for examination purposes as indicated is proper, wherein the restriction requirement can be made at any time before final action in the case at the discretion of the examiner (this office action is made non-final action).

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Indeed, as can be further seen the serious burden on the examiner, it is the fact that Applicants required the Examiner to search, examine and consider all of multiple distinct inventions which are described in five (5) foreign priority documents.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 13,18-26,30-38,47,56-57 are further withdrawn from further consideration.
3. Claims 1-11,14-17,27-29,39-46 and 48-55 were previously withdrawn from consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim, and already made final.

#### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

5. Claim 12 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 and 3 of U.S. Patent No. 6,517,744. Although the conflicting claims are not identical, they are not patentably distinct from each other, because the present claims of this present application are clearly anticipated by claims 4 and 3 of the Patent No. 6,517,744, and are broad enough to encompass scope of claims 4 and 3 of the Patent No. 6,517,744, wherein the magnetic fibrous filler as recited in claim 12 of this present application is anticipated by a magnetic substance and a carbon fiber (claim 4 of the Patent), and in which the magnetic substance adheres to the carbon fiber on its surface (claim 3 of the Patent).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipated by Hara et al (6,517,744).

The Hara et al reference including another inventor named “Ryoji Setaka” teach a process for producing a composite sheet in semi-cured form comprising the steps of: sheeting a composition for composite sheet into a sheet of given thickness, said composition comprising a magnetic fibrous filler (A) and a binder (B), said binder (B) comprising a photocuring component and a thermosetting component (column 50, lines 3-12), and not only applying a magnetic field to the composition sheet in the direction of the thickness of the composition sheet so as to orientate the magnetic fibrous filler (A) in the direction of the thickness of the composition sheet by also curing the photocuring component of the sheeted composition, thereby obtaining a semi-cured composite sheet (col 50, lines 13-19; and col 47, line 55 through col 48, line 40; Figs 5-7; cols 29-30).

(Noted that in the absence of objective evidence to the contrary (e.g. affidavit or declaration), the 6,517,744 reference of Hara above was made “by another” due to having different inventive entity with another inventor named “Ryoji Setaka”).

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8. Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipated by McArdle et al (6,180,226).

McArdle et al teach a process for producing a composite sheet in semi-cured form comprising the steps of: sheeting a curable composition for composite sheet into a sheet of given thickness, said curable composition comprising a magnetic fibrous filler (A) (col 20, line 43 through col 21, line 36; col 21, lines 32-35) and a binder (B), said binder (B) of the curable composition comprising a mixed composition having a photocuring component and a thermosetting component therein (column 18, line 50 through col 19; col 19, lines 34-46, lines 56-67; col 32, lines 32-45), and not only applying a magnetic field to the composition sheet in the direction of the thickness of the composition sheet so as to orientate the magnetic fibrous filler (A) in the direction of the thickness of the composition sheet by also curing the photocuring component of the sheeted composition, thereby obtaining a semi-cured or partially cured composite sheet (col 32, lines 3-45; col 6, lines 53-67; col 15, lines 60-65; and Figure 11, col 30, line 40 through col 32), wherein photocuring component is cured by light irradiation, and wherein thermosetting component is uncured and remained in the thin film sheet, wherein partially cured (semi-cured) thin film sheet is mentioned at column 3, lines 54-57.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jiang et al (6,011,307) taken with Wang et al (5,519,177).

Jiang et al teach a process for producing a composite sheet in semi-cured form comprising the steps of: sheeting a composition for composite sheet into a sheet of given thickness, said curable composition comprising a magnetic fibrous filler (A) and a binder (B) 112,214, said binder (B) comprising either a thermoplastic component or a thermosetting component (Figs 3-26; col 5, line 38 through col 9), and not only applying a magnetic field (Fig 15; col 6, line 65 through col 7, line 19) to the composition sheet in the direction of the thickness of the composition sheet so as to orientate the magnetic fibrous filler 114,212 (col 8, line 38 through col 9, line 40) in the direction of the thickness of the composition sheet by also partially curing the thermo component of the sheeted composition, thereby obtaining a semi-cured or partially cured composite sheet (col 5, lines 51-55).

Jiang et al lack using a composition having a binder comprising a photocuring component and a thermosetting component, wherein the photocuring component is cured thereby obtaining a semi-cured composite sheet.

However, Wang describes (at col 1, lines 63, 60-67) the adhesive and peeling problem of using the thermosetting resin component, then teaches (at col 2, line 20-27) the use of mixed resin including uncured thermosetting resin (as thermosetting component) including a resin substituted at a part of functional group with a photosensitive group (as photocuring component) and thermoplastic, and also teach (at column 20, lines 18-55) the use of a composition having a binder comprising a thermosetting resin with partly photosensitized (as photocuring component), wherein curing by irradiating an UV light cured the photosensitized component while the thermosetting component is uncured thereby obtaining a semi-cured composite sheet.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the composite sheet of Jiang by using the composition having a binder comprising having a binder comprising a thermosetting resin with partly photosensitized (as photocuring component) and thermoplastic, as taught by Wang. This is because of the desirability to form an adhesive layer having an excellent adhesive property so as to improve

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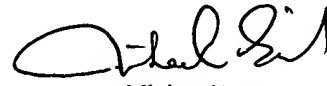
bonding strength, wherein curing by irradiating an UV light cured the photosensitized component while the thermosetting component is uncured thereby obtaining a semi-cured composite sheet.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Trinh whose telephone number is (703) 308-2554. The examiner can normally be reached on M-F from 8:30 Am to 4:30 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amir Zarabian can be reached on (703) 308-4905. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.  
Oacs-5



Michael Trinh  
Primary Examiner